UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,093	12/28/2001	Royce D. Jordan JR.	010569	2219

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EXAMINER
EL CHANTI, HUSSEIN A

ART UNIT	PAPER NUMBER
2157	

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/034,093	JORDAN, ROYCE D.
	Examiner	Art Unit	
	Hussein A. El-chanti	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>30 June 2006</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>6-17 and 19</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>6-17 and 19</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to amendment received on June 30, 2006. Claims 6-17

and 19 are pending examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 6-17 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by

Leonard et al., U.S. Patent No. 6,721,784 (referred to hereafter as Leonard).

As to claim 6, Leonard teaches a method for detecting and selectively preventing

the forwarding of an electronic message after receipt by the recipient, wherein the

electronic message has a unique message identifier, the method comprising:

coding the electronic message to indicate a request to prevent forwarding (see

col. 19 lines 47-67 and fig. 12, user may indicate that the email may not be forwarded,

copied, printed);

scanning the electronic message for a request to prevent forwarding (see col. 19

lines 47-67 and fig. 12);

storing the message identifier in a blacklist database whenever the request is

found (see col. 24 lines 10-38, control information of the email is stored in a database);

and

blocking forwarding by the recipient of the electronic message that has been

received by the recipient when the message identifier of the electronic message being

forwarded matches an entry in the blacklist database (see col. 24 lines 10-38, the

forwarding of the email is prevented if the control information in the database indicates

that the email cannot be forwarded).

As to claim 7, Leonard teaches the method of claim 6, wherein the electronic

message includes a message body, and wherein scanning includes searching the

message body for a request to prevent forwarding (see col. 12 lines 25-33).

As to claim 8, Leonard teaches the method of claim 7, wherein the electronic

message includes a message header, and wherein scanning includes searching the

message header for a request to prevent forwarding (see col. 12 lines 25-33).

As to claim 9, Leonard teaches the method of claim 8, further comprising:

selecting the electronic message in which to include the request to prevent forwarding

(see col. 12 lines 25-33).

As to claim 10, Leonard teaches a system for detecting and selectively

preventing the forwarding of an electronic message received by a recipient, wherein the

electronic message has a unique message identifier, the method comprising:

means for coding the electronic message to indicate a request to prevent forwarding;

means for scanning the electronic message for a request to prevent forwarding; means

for storing the message identifier in a blacklist database whenever the request is found; and means for blocking forwarding by the recipient of the electronic message that has been received by the recipient whenever the message identifier of the electronic message being forwarded matches an entry in the blacklist database (see col. 19 lines 47-67 and col. 24 lines 10-38).

As to claim 11, Leonard teaches the system of claim 10, wherein the electronic message includes a message body, and wherein the means for scanning includes searching the message body for a request to prevent forwarding (see col. 12 lines 25-33).

As to claim 12, Leonard teaches the system of claim 11, wherein the electronic message includes a message header, and wherein the means for scanning includes searching the message header for a request to prevent forwarding (see col. 12 lines 25-33),

As to claim 13, Leonard teaches the system of claim 12, further comprising: means for selecting the electronic message in which to include the request to prevent forwarding (see col. 12 lines 25-33).

As to claim 14, Leonard teaches a computer-readable medium having stored thereon instructions which, when executed by a processor, cause the processor to perform the steps of: coding an electronic message to indicate a request to prevent forwarding scanning the electronic message for a request to prevent forwarding; storing the a message identifier in a blacklist database whenever the request is found; and blocking forwarding by a recipient of the electronic message once the electronic

message has been received by the recipient whenever the message identifier of the

electronic message being forwarded matches an entry in the blacklist database (see

col. 19 lines 47-67 and col. 24 lines 10-38).

As to claim 15, Leonard teaches the medium of claim 14, wherein the electronic

message includes a message body, and wherein scanning includes searching the

message body for a request to prevent forwarding (see col. 12 lines 25-33 and col. 19

lines 30-67).

As to claim 16, Leonard teaches the medium of claim 15, wherein the electronic

message includes a message header, and wherein scanning includes searching the

message header for a request to prevent forwarding (see col. 12 lines 25-33 and col. 19

lines 30-67).

As to claim 17, Leonard teaches the medium of claim 14, further comprising:

selecting the electronic message in which to include the request to prevent forwarding

(see col. 12 lines 25-33 and col. 19 lines 30-67).

As to claim 19, Leonard teaches a computer readable medium containing

instructions that when executed by a computer perform the acts of:

receiving user input for preventing forwarding of one or more electronic mail

messages being sent to a recipient; storing matching input in a blacklist database; and

upon a subsequent attempt to forward one of the one or more received electronic mail

messages by the recipient who has received the one or more electronic mail messages,

referencing the user input relative to the matching input in the blacklist database and

preventing forwarding by the recipient wherein receiving user input comprises receiving

user input included in the header of an electronic mail message being created at a client computer where the user input from the header is referenced upon an attempt to forward the electronic mail message such that when the header of the electronic message being forwarded matches the input in the blacklist database, forwarding of the electronic message is blocked (see col. 19 lines 47-67 and col. 24 lines 10-38).

Response to Arguments

3.   Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new grounds of rejection.

4.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hussein A. El-chanti whose telephone number is (571)272-3999. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hussein Elchanti

Sep. 12, 2006

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